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EXAMINER

AHMAD, NASSER

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1772

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/674,108
Filing Date: September 29, 2003
Appellant(s): GOECKE, THOMAS R.

MAILED
SEP 18 2007
GROUP 1700

W. Scott Harders
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/19/2007 and 6/15/2007 appealing from the Office action mailed 10/19/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

However, it should be noted that rejection (B) therein should correctly read as: claims 7, 10 and 11 are unpatentable under 35 USC 103(a) as being obvious over Oace in view of Hughart and Guenther (see the Office Action of 10/19/2006, paragraph-9). The reference to Maurer in the body of the rejection was an inadvertent error by the examiner. Said error has been corrected in the rejections presented hereinbelow.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,559,990	OACE	07-1951
6,668,504	HUGHART	12-2003
6,461,715	GUENTHER	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1- 6, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oace (2559990) in view of Hughart (6668501).

Oace relates to an adhesive tape comprising a polymer backing film of 4 to 20 mils thickness (col. 4, lines 21-22) and an adhesive layer contacting the backing film (col. 5, lines 44-47). The backing can be polyvinyl chloride (col. 4, lines 43-60). However, Oace fails to expressly teach that the backing film has a Shore A Hardness of 92-100.

Hughart discloses an adhesive tape comprising a backing (36) of polymeric material such as polyvinyl chloride having Shore A Hardness of 92 and an adhesive layer attached thereto (col. 2, lines 38-45). Figures 1 and 3 shows the backing to be of substantially uniform thickness. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Hughart's teaching of providing an adhesive tape backing of polyvinyl chloride having a Shore A Hardness of 92 in the invention of Oace with the motivation to provide for hardness imparted for structural strength to the tape. For claim 2, Hughart teaches a substrate (30) is attached to the outermost side of the adhesive layer.

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Regarding claim 3, the presence of a textured surface on the backing is inherent of the backing to be able to bond to the adhesive layer.

Claim 5 is disclosed in col. 7, lines 66-67, wherein pigments can be added to the backing layer.

For claim 6, the tape backing is of polyvinyl chloride material is well in the art to be transparent (col. 7, lines 43-44).

For claim 9, it would have been obvious optimization, based on routine experimentation, to provide the backing of Hughart to have Shore A Hardness of 93-97 for optimizing the hardness of said backing polymer layer.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oace in view of Guenther (6461715).

Oace, as discussed above fails to teach that the peel adhesion of the adhesive layer is greater than 2.0 lb/in width. Guenther relates to an adhesive tape comprising a polymer layer (11) having a thickness of 50-500 microns (col. 7, lines 19-25) and a first side of the polymer layer has a double-sided adhesive layer (12) because it has two sides of adhesive surface. As shown in figure-2, one side of the adhesive layer is in substantially continuous contact with the first side of the polymer layer. The adhesive tape can be a pressure sensitive adhesive tape, including rubber-based adhesive (col. 8, lines 36-40). The tape has a peel adhesion of at least 3.5 N/cm (col. 8, lines 10-16), which would include the claimed peel adhesion of greater than 2.0 lb/in width. Therefore, it would have been obvious to one having ordinary skill in the art to utilize guenther's teaching by providing the adhesive layer to have a peel adhesion of at least 3.5 N/cm, which Claim 5 is disclosed in col. 7, lines 66-67, wherein pigments can be added to the backing layer.

For claim 6, the tape backing is of polyvinyl chloride material is well in the art to be

transparent (col. 7, lines 43-44).

For claim 9, it would have been obvious optimization, based on routine experimentation, to provide the backing of Hughart to have Shore A Hardness of 93-97 for optimizing the hardness of said backing polymer layer.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oace in view of Guenther (6461715).

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The intended use phrases such as "for application", "to adhere", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations

Claims 7,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oace in view of Hughart and Guenther.

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Oace and Hughart, as discussed above, fails to teach that the adhesive is a rubberized double-sided tape. Guenther, also discussed above, relates to a double-sided pressure sensitive adhesive (PSA). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Guenther's teaching of using a double-sided rubberized pressure sensitive adhesive tape in the invention of Oace with the motivation to provide for enhancing its peel adhesion characteristics.

(10) Response to Argument

Appellant argues, in page-5 (of Appeal Brief) that *Far from incorporating more relevant art, the Office has cited new references directed to subject matter even further from the claims than before, such as a reference directed toward sound-deadening wall board.* This is not convincing because it should be noted that instant independent claims 1 and 11 are directed to an **adhesive tape**, while independent claim 12 is directed to an **adhesive tape for application to a flooring**. Thus, the claims are directed to an adhesive tape and the applied prior art are also in the same filed of endeavor, in that said prior art are also directed to adhesive tape.

Regarding the inadvertent error in the rejection which cited the Maurer reference, appellant's observation is correct in that the Maurer was mistakenly cited in the Office Action of 10/19/2006. A closer look of said rejection would also show that Maurer was not cited in the heading portion of said rejection. Please note that said rejection has been corrected to recite Oace, which has been substituted for Maurer, to overcome the confusion.

Responding to appellant's argument that the prior art are non-analogous, in page-6 of Appeal Brief, appellant is informed that the cited prior art teaches an adhesive tape

comprising a polymer layer with adhesive attached thereto, which is the structure being claimed in the instant application.

Regarding the patent statutes discussed by the appellant in the Appeal Brief, page-7, appellant is directed to explanations provided hereinabove showing that the applied arts are in the same filed of endeavor as the applicant's claimed invention, i.e., the adhesive tape comprising a polymer layer having an adhesive layer attached thereto.

In response to the argument made in page-8 of the Appeal Brief, appellant is directed to the above provided explanation that applies *a fortiori* herein for the argument that Oace and Hughart are non-analogous. Further, appellant is informed that Hughart does suggest the polymer layer having a Shore Hardness of 92. Specifically, the element 36 of Hughart is interpreted to be an adhesive tape because it comprises a polymer layer having an adhesive layer affixed thereto, as claimed by the applicant in instant claim 1. Hughart was cited to show that polyvinyl chloride polymer material of an adhesive tape is known to have Shore hardness of 92 for providing strength characteristic to the polyvinyl chloride adhesive tape polymer layer in the invention of Oace. Further, appellant has failed to show otherwise.

As for the argument regarding claim 2, appellant is directed to Hughart, figure-3, and the Office Action of 10/19/2006, paragraph-7, wherein it is shown that the substrate is attached to the outermost side of the adhesive layer.

As for claim 3, the polymer layer would inherently have a textured surface because it is well known in the adhesive art to increase the adhesion between a backing layer and the adhesive thereon by making the backing surface textured, thereby increasing the surface area to enhance the adhesive adhering thereto. In the alternative, figure-3 of Hughart shows a hole in the element 36 which opens to the surface thereof, which can be taken to be a textured surface of the polymer layer.

Responding to the arguments for claims 5 and 6, this is not persuasive because appellant has discussed the Shore hardness feature of the polymer layer and not the features of claims 5 and 6.

As for the argument for claim 9, appellant is directed to the Office Action, paragraph-7, wherein it has been explained that a Shore hardness of 93 is found to be obvious optimization of the Shore hardness of 92 of Hughart, in the absence of any showing by the appellant that the polymer layer will exhibit distinct characteristics at said Shore hardness numbers.

Moving onto the rejection of claim 12, appellant is directed to the Office Action of 10/19/2006, paragraph-8, wherein it has been explained that the polymer layer (11) has an adhesive layer attached thereto, that the adhesive is a double-sided adhesive layer as it has two sides that exhibit adhesive properties, and that Guenther was cited to show that the tape exhibits a peel adhesion of at least 3.5N/cm, which includes the claimed peel adhesion of 2.0lb/in.width. Again, appellant has failed to show that the cited prior art would not exhibit a peel adhesion of at least 3.5N/cm.

Additionally, applicant calculation of 500 microns=0.019685 inches (see Appeal Brief, page-11, footnote) is not found to be convincing because the prior art teaching of 500 microns=20 mils=0.02 inches because conventionally 1 mil=25 microns. Assuming *arguendo* that appellant's calculation is correct, even then there is no showing as to the distinct characteristics displayed by polymer layer at 0.020 inches (20 mils) and 0.019685 inches.

Turning to the rejection of claims 7, 10 and 11, the arguments have been explained hereinabove which apply *a fortiori* herein. Aso, Applicant's observation regarding the inadvertent error in citing Maurer, instead of Oace, is acknowledged and in the rejection in paragraph-9 in the Office Action Of 10/19/2006 has been addressed hereinbefore.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

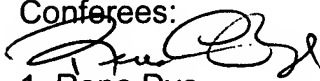
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Nasser Ahmad

Conferees:



1. Rena Dye

SPE, Art Unit 1772



2. Romulo Belmendo

Appeals Specialist, TC 1700